

ATTORNEY DOCKET NO.
AUS920010804US1 (IBM 2332000)

PATENT APPLICATION
SERIAL NO. 09/998,400

REMARKS

The Office Action dated February 23, 2005 in this Application has been carefully considered. Claim 1-24 are pending. The above amendments and the following remarks are presented in a sincere attempt to place this Application in condition for allowance. Claims 1, 7, 13 and 19 have been amended in this Response. New Claim 24 has been added in this Response. Reconsideration and allowance are respectfully requested in light of the above amendments and the following remarks.

Applicant wishes to thank the Examiner for the courtesy of the interview conducted on May 13, 2005. During the interview, the above-referenced amendments were discussed. Tentative agreement was reached that such amendments patentably distinguish from the art currently of record. However, the Examiner indicated that such agreement was subject to completion of additional search and further consideration of any material references found. Further, the Examiner indicated that the Applicant must point to support in the Specification for the amendments. Since the Examiner wished to expedite examination following completion of any additional search, the Examiner is invited to contact the undersigned to discuss any issues raised or remaining.

Page 10, line 21 of the Specification is amended to correct a typographical error. Specifically, "510" is corrected to read "508." Applicants contend that the rationale underlying this amendment bears no relation to any equivalence because the error was corrected merely for consistency of terminology. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831 (2002).

Claims 1-23 stand rejected under 35 U.S.C. §101 as being directed towards non-statutory subject matter, an abstract idea. Applicants have amended these claims to clarify that the claims are directed to statutory subject matter. As amended, the claims are directed toward physical

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embodiments of a computer-readable program product, a method implemented on one or more computers and computer-based apparatus. Accordingly, Applicants respectfully request that the Section 101 rejections of these claims be withdrawn. The two independent Beauregard claims, Claims 1 and 7, are amended to state that the medium is a "computer-readable" medium. The remaining Beauregard claims, Claims 2-6 and 8-12 are dependent upon Claims 1 and 7 and should also now be deemed allowable for the reasons stated with respect to Claims 1 and 7. Independent method claim, Claim 13, is amended to state that the method is "implemented on one or more computers". The remaining method claims, Claims 14-18, are dependent upon Claim 13 and should also now be deemed allowable for the reasons stated with respect to Claim 13. Independent system claim, Claim 19, is amended to state that the apparatus is a "computer-based" apparatus. The remaining system claims, Claims 20-23, are dependent upon Claim 19 and should also now be deemed allowable for the reasons stated with respect to Claims 19. Applicants respectfully contend that the rationale underlying these amendments bears no relation to any equivalence, because the amendments were made merely for clarification of a limitation implicitly found in the amended claims. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831 (2002).

The amendments are supported by the Specification, and no new matter is added. Specifically, at page 1, lines 6-7, the invention is described as "relat[ing] generally to logic testing using a computer program." The Specification refers to many components of the invention as capable of implementation on a computer. The Specification also describes a "software model" and a "simulator" running in a "software environment." Page 7, line 4; page 10, line 19 (software model); page 7, line 1; page 7, line 13 (simulator); page 7, line 2; page 7, line 8 (software environment). At page 6, lines 8-9, the software model is described as a computer file. Similarly, at page 10, line 20, an extractor is described as another computer program. At page 7, lines 8-10, a

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software environment is described as an environment which "reads, writes, and interprets files for stimulating inputs and/or reading outputs." Many other references to implementation of computers and aspects of the computer environment can be found in the Specification as well.

In addition, Claim 24 in a new independent claim. Applicants respectfully submit that support for this claim is provided throughout the original Application. Applicants have now made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests full allowance of Claims 1-24.

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Applicants hereby authorize the Commissioner to charge the fee required under 37 CFR 1.16(h) for one independent claim in excess of three plus the fee required under 37 CFR 1.16(i) for one claim in excess of 20 to Deposit Account No. 50-0605 of CARR LLP. Applicants do not believe that any other fees are due; however, in the event that any other fees are due, the Commissioner is hereby authorized to charge any required fees due (other than issue fees), and to credit any overpayment made, in connection with the filing of this paper to Deposit Account No. 50-0605 of CARR LLP.

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,

CARR LLP



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